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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,994	11/26/2003	Tomohiro Miyashita	XA-9999	6540
181	7590	12/14/2005	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/721,994

Applicant(s)

MIYASHITA, TOMOHIRO

Examiner

Joshua L. Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-8, 10, 11 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to Amendment after non-final rejection filed October 14, 2005. Claims 3, 5-8 and 19 have been amended, claims 20-22 have been added and claims 1, 2 and 9 have been cancelled as requested by the applicant.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-8, 10, 11 and 19-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, drawings and claims as originally filed fails to teach or suggest an intermediate magnification varying part rotatable relative to the objective lens.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, 10 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki (US 6,128,128) in view of Kusaka (US 2001/0040723).

Regarding claims 3 and 5, Otaki teaches a microscope system (Fig. 1) comprising an objective lens (L1) and an intermediate magnification varying part disposed just after the image side of the objective lens (L2-L8; Figs. 6 and 8). Otaki teaches the intermediate magnification varying part includes a lens group having a positive refractive power and a lens group having a negative refractive power and in high magnification the lens group having a positive refractive power disposed just after the image side of the objective lens (Fig. 6; magnification 10x; objective L1, positive power L2; negative power L3 and L4 cemented together) while in a low magnification the lens group having a negative refractive power is disposed just after the image side of the objective lens (Fig. 8; magnification 2x; objective L1; positive power L8; negative power L2). Otaki teaches the intermediate magnification varying part is constructed in such a way that its optical system is rotatably with an axis substantially orthogonal to an optical axis being a rotation axis (Figs. 1 and 2). Fig. 1 shows that the optical axis of the light beam through the microscope bends at several locations providing several different optical axes. Fig. 2 shows the rotation axis (20 Ax), which in the broadest reasonable interpretation of the phrase

“substantially orthogonal” meets the claim limitations for one of the optical axes shown in Fig. 1. Otaki lacks reference to the intermediate magnification part rotatable relative to the objective. Kusaka teaches an intermediate magnification part (12) rotatable relative to the objective (Figs. 12A-B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Otaki invention include the rotatable intermediate magnification part of Kusaka for the purpose of centering the image to the eyepiece of the microscope to allow easier viewing of the image by an observer.

Regarding claims 4, 6, 10 and 11, Otaki teaches the microscope optical system is provided with a connecting portion (20) on the image side of the intermediate magnification varying part and the microscope optical system can be connected with a body of a microscope by means of the connecting portion (Fig. 1).

Claims 7, 8, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki (US 6,128,128) in view of Kusaka (US 2001/0040723) as applied to claims 3 and 5 above further in view of Yonezawa (US 6,320,702).

Otaki in combination with Kusaka teaches the invention as claimed but lacks reference to the claimed magnification state ratios. Yonezawa teaches moving lenses within the intermediate magnification varying part along the optical axis to change the magnification (abstract). After combining the teachings of both Otaki and Yonezawa one of ordinary skill in the art would be able to set the magnification to a wide variety of settings, which depending on the preference of the operator would fall within the claimed magnification ranges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Otaki invention

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include the movable lenses of Yonezawa in the intermediate magnification varying part for the purpose of allowing both rough and fine tuning adjustments to the magnification state of the microscope to allow observation of large areas and quickly be able to zoom in or out of smaller areas within the large area of observation.

Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki (US 6,128,128) in view of Kusaka (US 2001/0040723) as applied to claims 3 and 5 above further in view of Saito (US 6,188,514).

Otaki in combination with Kusaka teaches the invention as claimed but lacks reference to the claimed Abbe number and working distance relationship. Saito teaches the objective lens (4) comprises in order a first lens group and a second lens group (first group before d20 and second group after d20; Fig. 3) the first lens group includes a positive meniscus lens with the concave surface facing the object side (lens between r1 and r2; Fig. 3) and one or more cemented lenses (lenses between r9 and r11; Fig. 3) the first lens group having a positive refracting power as a whole (Fig. 3) at least one of the cemented lenses includes a lenses having an Abbe's number equal to or greater than 80 (Table 1) and the following conditions satisfied  $0.3 \leq wd/f \leq 0.45$  (col. 11 lines 20-22), Saito teaches a ration of 0.42, and  $0.6 \leq NA$  (col. 11 line 21), Saito teaches a numerical aperture of 0.95, where wd is the working distance, f is the focal length and NA is the numerical aperture.

### *Response to Arguments*

Applicant's arguments, see Amendment, filed October 14, 2005, with respect to the rejection(s) of claim(s) 3 and 5 under Otaki have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration of the newly amended claims, a new ground(s) of rejection is made in view of Otaki in view of Kusaka. Applicant argues that Otaki fails to teach or suggest an intermediate magnification varying portion rotatable relative to the objective lens. Although this limitation is rejected as new matter, the Kusaka reference has been added to teach the newly claimed limitation.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Noguchi (US 5,424,803) teaches a magnifying lens within a microscope turret being adjustable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP 

  
**DREW A. DUNN**  
**SUPERVISORY PATENT EXAMINER**